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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q63518

Shinoobu TANAKA

Appln. No.: 09/883,279

Group Art Unit: 2167

Confirmation No.: 1528

Examiner: Frank E. Werner

Filed: June 19, 2001

For: SINGLE LEVER WITH BUTTON FOR SELECTIVELY CONTROLLING EITHER
TILT OR LIFT OF A FORKLIFT MECHANISM

SUBMISSION OF APPELLANT'S BRIEF ON APPEAL

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an original and two copies of Appellant's Brief on Appeal. A check for the statutory fee of \$330.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 14, 2004

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APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 1.192, Appellant submits the following:

I. REAL PARTY IN INTEREST

Based on information supplied by Appellant and to the best of the Appellant's legal representative's knowledge, the real party in interest is the assignee, NIPPON YUSOKI CO., LTD.

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APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/883,279

II. RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences known to Appellant, Appellant's legal representative, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

Claims 1 and 2 stand rejected under 35 U.S.C. § 112, first paragraph, and claims 3-9 are allowed.

IV. STATUS OF AMENDMENTS

No proposed claim amendments have been made after the final Office Action dated July 15, 2003 ("Final Office Action"). Therefore, all amendments to the claims, which have been made during the prosecution of the present application, have been entered.

V. SUMMARY OF THE INVENTION

Figs. 1 and 2 show an illustrative, non-limiting embodiment of the invention which relates to a forklift 1. The forklift 1 contains an operating lever 3 for lifting and lowering of a fork 5, and tilting of a mast 4 (pg. 4 of Application). The operating lever 3 contains a switch 9 disposed at an end of a gripping portion of the lever.

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/883,279

Furthermore, when the switch 9 of operating lever 3 is not operated, the lifting and lowering speeds of the fork 5 are controlled by the degree of opening of a first solenoid proportional control valve 61, which in turn is proportional to a tilting angle of the operating lever 3 (pg. 4; Figs. 3). On the other hand, when the operating lever 3 is tilted while the switch 9 is operated, the tilting speed of the mast 4 is controlled in proportion to the degree of opening of a second proportional control valve 62, which in turn is proportional to a tilting angle of the operating lever 3 (pg. 4; Fig. 3).

In a non-limiting implementation of the invention, an inhibiting circuit 72 is activated to stop a tilting action of the mast 4, as well as a lifting or lowering action, when the switch 9 is released at a time during operation of operating lever 3 (pg. 5). Once the operating lever 3 is returned to a neutral position, the activation of the inhibiting circuit 72 is canceled, such that operation of the fork 5 and mast 4 can be resumed (pg. 5).

VI. ISSUE

Are claims 1 and 2 unpatentable under 35 U.S.C. § 112, first paragraph, for failure to comply with the written description and enablement requirements?

VII. GROUPING OF CLAIMS

Claims 1 and 2 stand or fall together.

VIII. ARGUMENTS

Claims 1 and 2 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner maintains that claim 1 allegedly contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 is rejected as being dependent upon allegedly non-enabled claim 1 (pg. 2 of the Final Office Action).

In view of the Examiner's statements, Appellant assumes that the Examiner also intended to reject the claims as failing to comply with the "written description" requirement, as containing subject matter not supported by the specification as filed.

Appellants will address both issues below:

Regarding claim 1, the Examiner maintains that the specification is allegedly "not enabling for the second switching state to both enable and disable the lifting and lowering of the forks..." (pg. 2 of the Final Office Action; Continuation Sheet of October 22, 2003 Advisory Action). However, as an initial matter, Appellant submits that the Examiner has misconstrued the recitations of claim 1. For example, lines 11-13 of claim 1 do not recite that lifting and lowering of the fork are enabled and disabled in the second switching state, as maintained by the Examiner. Rather, claim 1 recites that the lifting and lowering of the fork are prevented when the switch is changed from the first switching state to the second switching state, while the operating lever is tilted.

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/883,279

Based on a proper construction of claim 1, Appellant submits that the specification fully complies with the written description requirement of 35 U.S.C. § 112, first paragraph. For example, as stated in the description of the non-limiting embodiment on page 5 of the specification, when the operating lever 3 and the switch 9 are operated, the mast 4 can be tilted. However, if the switch 9 is released during operation of the operating lever 3, an inhibiting circuit 72 is activated to stop both the tilting and lifting/lowering actions (i.e., "When the switch 9 is released during this operation, an inhibiting circuit 72 shown in Fig. 3 is activated so as to block the pulse generation in a pulse generating circuit 73, thereby stopping the tilting action of the mast 4 and the lifting or lowering action." pg. 5, first full paragraph).

Accordingly, the claimed "first switching state" is when the switch 9 is operated, and the claimed "second switching state" is when the switch 9 is not operated. Therefore, as defined in claim 1, if the switch 9 is released (i.e. changed from the first switching state to the second switching state) during operation of the operating lever 3, an inhibiting circuit 72 is activated to stop both the tilting and lifting/lowering actions (pg. 5 of specification).

Although the specification does not explicitly use the terms "first switching state" and "second switching state", Appellant asserts that the specification complies with the written description requirement since the specification, "need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed." *All Dental Prodx, LLC v. Advantage Dental Prods.*, 309 F.3d 774,779; 64 USPQ2d 1945, 1950 (Fed. Cir. 2002).

APPELLANTS' BRIEF ON APPEAL
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In addition, “[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778,785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). In view of Appellant’s comments regarding the specification, as set forth above, Appellant submits that the specification is fully enabled, and that one skilled in the art would know how to make and use the invention defined by the claims.

In summary, Appellant submits that the written description requirement is clearly met since the specification fully describes the claimed subject matter (as required by MPEP § 2163.01). Furthermore, Appellant submits that the specification describes the invention in such terms to enable one skilled in the art to make and/or use the present invention (as required by MPEP § 2164).

Accordingly, Appellant respectfully requests the Board to reverse the rejection under 35 U.S.C. § 112, first paragraph.

IX. CONCLUSION

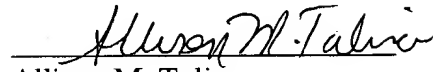
The present Brief on Appeal is being filed in triplicate. Unless a check is submitted herewith for the fee required under 37 C.F.R. § 1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

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Respectfully submitted,



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APPENDIX

CLAIMS ON APPEAL:

1. A load handling apparatus for a forklift, comprising:

one tiltable operating lever disposed on a body of the forklift;

a mast tiltable in an anteroposterior direction and disposed on the body of said forklift;

a liftable fork disposed on said mast;

a solenoid proportional control valve, in which a tilting speed of said mast and lifting and lowering speeds of said fork are controlled by a degree of opening of said solenoid proportional control valve, said degree of opening being proportional to a tilting angle of said operating lever;

a switch attached to said operating lever; and

a controller that tilts said mast when said operating lever is tilted and said switch is in a first switching state, that lifts or lowers said fork when said operating lever is tilted and said switch is in a second switching state, and that prevents lifting and lowering of said fork when said switch is changed from said first switching state to said second switching state while said operating lever is tilted.

2. A load handling apparatus as claimed in claim 1,

wherein said controller includes an inhibiting circuit for stopping the tilting action of the mast and the lifting or lowering action of the fork when said switch is switched from said first switching state to said second switching state while said operating lever is being operated.